

**R E M A R K S**

Claims 1, 5-8, and 10-23 are pending in the above captioned patent application. The Examiner made the following rejections:

- (1) Claims 1, 5-8, and 21-23 were rejected under 35 U.S.C. 112.
- (2) Claims 10-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,647,675 to Mayer *et al.*, in view of U.S. patent 4,900,686 to Arnost *et al.* and / or U.S. patent 5,846,737 to Kang.

The Applicants address the rejections in the same order presented in the Office Action referenced above.

**1. The Claims Are Compliant With 35 U.S.C. § 112**

At the outset, applicants must *again* strongly protest the Examiner's continued reliance on *Ex parte Fressola*. For reasons of record, the holding in the *Ex parte Fressola* opinion has no bearing on the claims at issue.

With regard to the specifics, the Examiner suggests that the recitation of such phrases as "conjugating the fluorophore with a biomolecule" and "determinable wavelength" somehow compromise the definiteness of the invention as claimed. Without agreeing with the Examiner, but to further the prosecution, and hereby expressly reserving the right to prosecute the original claims (or similar claims) in the future, Claims 1 and 21 have been amended so as to delete the term "determinable" and include the language "wavelength of 500 to 700 nm" which is supported in the specification.<sup>1</sup> In addition, the preambles of Claims 1 and 21 have been amended to track the precise language found in the body of each claim. Finally, minor additional changes have been made to direct the claims to one embodiment of the invention (without waiving the right to prosecute claims in the future lacking such changes).

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<sup>1</sup> Specification, pg. 8, lines 8-10.

The amendments are believed to be sufficient to overcome the rejection. Therefore, the rejection should be withdrawn.

## **2. The Claims Are Not Obvious**

There is no obviousness rejection in the context of Claims 1 and 5-8. In view of the above-noted amendments, Claims 1 and 5-8 should be allowed.

On the other hand, the Examiner rejects Claims 10-20 under 35 U.S.C. 103(a) as being unpatentable over Mayer *et al.*, US 4,647,675, in view of Arnost *et al.*, US 4,900,686, and Kang US 5,846,737. In response, the previous arguments are hereby reaffirmed.

Specifically, Mayer *et al.* describe (in part) the *cosmetic* dyeing of leather, plastics and paper stocks. In contrast, Claim 10 is directed to an embodiment wherein the compound is part of a conjugate with a biomolecule (e.g. protein, nucleic acid etc.). Also, as noted in Applicants previous correspondence of record, U.S. patent 5,846,737 to Kang *teaches away* from the present invention. That is to say, Kang is directed exclusively to conjugates of *sulforhodamine*. In view of the present invention, the sulphate group on a sulforhodamine causes an unfavorable stearic interaction which substantially prevents the conjugation of an organic compound with a fluorophore as claimed. The Examiner is reminded that a reference which teaches away from the invention as claimed is evidence of *non-obviousness*.

The Applicants have, in previous correspondence, scrupulously documented the Examiner's consistent failure to provide any (evidence based) motivation for the combination of the cited art. That is to say, Applicants have shown how Mayer *et al.* provides no motivation (or suggestion) for the conjugation of rhodamine and, therefore, cannot be properly combined with either Arnost *et al.* or Kang. In addition, Applicants have documented how all of the cited art is silent on the resistance of lactam ring formation during the conjugation of rhodamine at a 3-carboxylamide position (which is recited as a claim element).

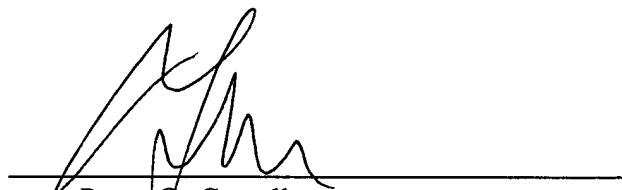
Notwithstanding the specific evidence offered by the Applicants regarding, i) the Examiner's failure to make a *prima facie* case of obviousness and ii) the deficiencies (even if improperly combined) of the cited art; the Examiner continues to perpetuate the faulty rejection, under 35 U.S.C. §103, with bald conclusion. Specifically, the Examiner appears to rest his rejection on his allegation that, "it is well known in the art that rhodamine dyes are used in making protein conjugates." This statement is insufficient. The Examiner has not

shown that one skilled in the art would be motivated to conjugate the specific fluorophores claimed. At most, the Examiner's argument is an "obvious to try" argument - which is a discredited approach to obviousness.

#### CONCLUSION

Applicants believe the amendment and arguments, set forth above, traverse the Examiner's rejections and request these grounds for rejection be withdrawn and that the pending claims be passed to allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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